

REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the January 11, 2008 Office Action. In response, applicant has incorporated the recitations of claim 4 into claim 3, and canceled claim 4, and added new claims 28-31. In light of these amendments, and the following remarks, applicant respectfully requests reconsideration and reexamination of the application.

CLAIM REJECTIONS

Claims 1, 3-5, 9, 10, 12-16, 20, 21 and 25-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kraus (U.S. Patent No. 2,984,281) in view of Oswald (U.S. Patent No. 4,830,781).

The present invention is directed to a method for manufacturing an animal chew toy. As recited in independent claim 1, first and second layers of rubber material formed in a general shape and size of the animal chew toy are provided. A floss material comprising at least one mesh fabric sheet of synthetic fibers formed in a general shape and size of the animal chew toy is placed between the first and second layers of rubber material. The sheets of rubber and floss material are molded into the animal chew toy by compressing the sheets of rubber and floss material between opposing mold members under pressure and heat.

Independent claim 14 has similar recitations, but specifies that the first and second layers of rubber material are of tire rubber material cut into a general shape or size of the animal chew toy. Moreover, the floss material comprising a synthetic fiber mesh is cut into the general shape or size of the animal chew toy.

Independent claim 21 includes similar recitations as independent claims 1 and 14, but specifies that the first and second layers of rubber material are tire rubber material comprised of natural or synthetic rubber mixed with carbon black cut into a general shape or size of the animal chew toy, and that the sheet of floss material comprises a nylon or polyester fiber mesh cut into the general shape or size of the

animal chew toy, which is then placed between the first and second layers of rubber material before the compression step.

On page 3, it is admitted in the Office Action that Kraus does not specifically teach the use of a floss material comprising a mesh molded between the two sheets of rubber material. It was asserted in the Office Action that Oswald teaches that it is conventional to mold a fiber mesh material between two sheets in a tire. However, applicant respectfully asserts that the methodology used by Oswald is significantly different than the methodology of the present invention.

Oswald teaches of the use of an individual continuous cord strand which is interleaved and woven onto a base and sidewall 16, followed by the application of the tread portion of the tire. Oswald teaches of a substantially zig-zag pattern for the cord lengths forming a tread section 18 underlying the tread, while having cord length that lies substantially parallel to each other in the sidewall region 20. A number of coated continuous cord lengths 26 are disposed in zig-zag repeating pattern with succeeding lengths of the strips being displaced from each other. The cord lengths are interleaved with lengths of cord disposed at an opposite angle along at least one line substantially parallel to and intermediate the sides of tread section. This interleaving relationship results in a woven structure. (See column 4, lines 30-50). As described in column 4, lines 62-66, the individual continuous cord reinforcement strands are embedded in or coated with a suitable rubber or other polymeric material. With reference to FIGS. 1, 4A and 4B, Oswald teaches that the weaving of tire reinforcing belts is known in the art by moving weaving heads supplying cord to the surface in timed relationship to the movement of the surface. As further stated in column 5, the weaving of the individual cords is performed on the underlying carcass or sidewalls of the tire, as the tire is created.

It will be appreciated by those skilled in the art that the complicated weaving pattern, necessary weaving heads, etc. to create the desired pattern of Oswald onto an underlying tire carcass, before the tread is applied thereto, is significantly more complicated and expensive than the methodology of the present invention. The

methodology of the present invention does not require moving weaving heads supplying rubber coated cords into a complicated weaving pattern having a zig-zag configuration and generally spaced apart in parallel relationship along sidewalls of the tire carcass during formation of the tire. Instead, in accordance with claim 1, first and second layers of rubber material are already formed in a general shape and size of the animal chew toy. A sheet of synthetic fibers is also formed in a general shape and size of the animal chew toy, and placed between the first and second layers of rubber material. These layers are then compress molded under pressure and heat into the animal chew toy. Such a complicated and expensive weaving head arrangement is not required by the present invention, and a combination of Kraus and Oswald fail to render independent claim 1 obvious.

For similar reasons, the combination of Kraus and Oswald fail to render independent claims 14 and 21 obvious as well. As stated above, independent claims 14 and 21 specify that the first and second layers of rubber material are cut into a general shape or size of the animal chew toy. A floss material comprising a synthetic fiber mesh which is cut into the general shape or size of the animal chew toy is placed between the first and second layers of rubber material, before they are compressed under pressure and heat to mold the first and second layers of rubber material and floss material into the animal chew toy. Once again, the combination of Kraus and Oswald fail to disclose pre-cut sheets of rubber material and fiber mesh material which are layered and subsequently molded.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)). As Kraus and Oswald fail to teach or suggest all the claim limitations of the independent claims, a *prima facie* case of obviousness has not been established and independent claims 1, 14 and 21 are patentably distinct from these references.

If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, dependent claims 3, 5, and 7-31 are non-obvious as well, and patentably distinct from the cited references.

With respect to the statement in the Office Action on page 4 that “with regard to the ‘cut’ state of the rubber and synthetic fiber, it is submitted that the woven mesh and rubber material have a shape which is generally the same as a ‘cut’ shape, and in the alternative, it would have been obvious to cut the mesh and rubber to fit the tire”, there is absolutely no basis for this assertion in either the Kraus or Oswald references.

The fact that a prior art reference can be modified to show the patented invention does not make the modification obvious unless the prior art reference suggests the desirability of the modification. An attempted modification of a prior art reference that is unwarranted by the disclosure of that reference is improper. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

As stated in M.P.E.P. 2144, it is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”).

With respect to claim 13, the present invention is an animal chew toy, and as such has a diameter between six and ten inches, and does not include embedded metal therein. The Kraus and Oswald references are clearly directed to tires for vehicles, and as such are not analogous to the animal chew toy field, and fail to disclose that their tires are between six and ten inches in diameter.

As stated in the M.P.E.P., the claim preamble is necessary to give life, meaning and vitality to the claim in which the claim preamble should be construed as if in the balance of the claim, see M.P.E.P. 2111.02. As such, the field of endeavor or prior art

which should be considered should be in the animal chew toy fields, not in unrelated fields.

Claims 7, 17 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kraus, in view of Oswald, and further in view of Spross (U.S. Patent No. 1,596,071). It was admitted that Kraus and Oswald are silent with respect to a rope. Applicant respectfully submits that this is due to the fact that Kraus and Oswald are directed to the creation of tires to be used in association with vehicles or the like, and that it would not make any sense whatsoever to associate a rope therewith.

Spross is directed to the creation of a tire swing for people, and in particular children. Spross teaches the binding of several tires to one another and hanging this tied tire arrangement from an elevated position so as to create a swing. Applicant respectfully submits that one of ordinary skill in the field of animal chew toys would not look to Spross. The Spross reference is completely non-analogous to the present invention, and is also non-analogous to Kraus and Oswald. In the present invention, the purpose of the attached rope is to provide a handle-hold for the user to hold the animal chew toy while the animal chews thereon, in a playful manner, or even to throw the animal chew toy. Such is not the case with Spross, which uses the rope to interconnect multiple tires to one another and hang this tire arrangement from a tree limb, beam or the like to create a swing.

Obviousness cannot be established by combining the teachings of prior art references to produce the claimed invention absent some teaching or suggestion supporting the combination. The teachings from different references can be combined to invalidate a patent only if there is some teaching or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 932-933 (Fed. Cir. 1984).

It is improper to use the patent in suit as a guide through a maze of prior art references, combining the right references in the right way so as to achieve the results of the claims sought to be invalidated. *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199-200 (Fed. Cir. 1983). Applicant

respectfully submits that the Examiner has used the patent application as a guide through a maze of prior art to combine otherwise non-analogous references and to read similarities between those references to the present invention without taking these references as a whole, including those portions which teach away from the invention and would lead away from obviousness.

With respect to claims 8, 18 and 23, these were rejected as being unpatentable over Kraus, in view of Oswald, and further in view of McClung, III (U.S. Patent No. 5,799,616). It was admitted that Kraus and Oswald are silent with respect to a treat, however McClung, III teaches a disk-shaped body being used to hold an animal treat. It was asserted, somewhat absurdly, that one of ordinary skill in the art at the time of the invention would incorporate the method of McClung, III into Kraus. However, this analysis completely fails to take into account the teachings of these references, and the present application, in their entirety. No one of ordinary skill in the art would insert a treat into a tire made for a vehicle, as is taught by Kraus and/or Oswald. There would be absolutely no motivation for this, other than the teachings of the present invention. However, the teachings of the present invention are directed to an animal chew toy, wherein there is a desire to insert animal treats into the chew toy to enhance the experience of the animal chewing the chew toy.

The Examiner picks and chooses aspects of the references in light of Applicant's claims in attempting to reconstruct Applicant's invention. The Examiner's assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention.

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

Uniroyal Inc. vs. Rudkin-Wiley Corp. 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the

"insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

Ecolochem Inc. v. Southern California Edison, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffett*, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

Claims 9-11, 19, and 24 were rejected under the combination of Kraus in view of Oswald, and further in view of Eby (U.S. Patent No. 3,728,749) or Ogura (U.S. Patent No. 4,098,214). Both Eby and Ogura disclose a float made of an automobile tire. Eby discloses that used tire bodies can be converted into marine floats for use as moorings, buoys or the like. Similarly, Ogura teaches of converting tires into float devices used to keep afloat a mooring, lighted or other buoys intended to aid in navigation, rafts, shellfish planting or the like.

Once again, these references are completely non-analogous to the present invention. While they may disclose inserting buoyant material into an automobile tire, the purpose is completely different than the present invention. In the present invention, the purpose of the buoyant material is so that the toy can be thrown into water, float, and be easily retrieved by the dog or other animal. In the cited Eby and Ogura patents,

the purposes are completely different than that of the present invention, and there is no discussion whatsoever of the creation of an animal chew toy.

The claimed invention must be viewed as a whole. *Bausch & Lomb, Inc.*, 796 F.2d at 449 [230 USPQ at 420] (citing *Jones v. Hardy*, 727 F.2d 1524, 1527-1528, 220 USPQ 1021, 1023-1024 (Fed. Cir. 1984)). The proper test in analyzing the prior art is whether the prior art reference, taken as a whole, would have suggested the invention to an ordinary person skilled in the art. *Jones*, 727 F.2d at 1530, 220 USPQ at 1026. Applicant respectfully asserts that one of ordinary skill in the art of manufacturing animal chew toys would not look to any of the cited references, let alone the combination of Kraus, Oswald, and either Eby or Ogura, in the creation of animal chew toys. Taking these references as a whole, they would not have suggested the invention to one of ordinary skill in the animal chew toy art.

New claims 28-30 have been added specifying that the sheets of rubber material and floss material are compressed and molded into a flying disk configuration, a bone configuration, or an elongated cylindrical retriever configuration. These configurations are illustrated and described in the present application. However, none of the references teach of such configurations, and instead nearly all of the references are directed to automobile tires. As the references fail to disclose these recitations, applicant submits that they are patentably distinct from the cited references and should be allowed as well.

In light of the foregoing amendments and remarks, applicant respectfully asserts that the currently-pending claims are all patentably distinct from the cited references, and in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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